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#10

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/571,802 12/13/95 ISHII

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HM22/1208

EXAMINER

PAK, M

ART UNIT

PAPER NUMBER

1646

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DATE MAILED:

12/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/571,802

Applicant(s)

Ishii

Examiner

Michael Pak

Group Art Unit

1646



☒ Responsive to communication(s) filed on Sep 14, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24-71 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24-71 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Amendment

1. The amendment filed 14 September 1999 (paper No. 20) has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office actions.
3. Applicant's arguments filed 14 September 1999 (paper No. 20), have been fully considered but they are not found persuasive.

Claim Rejections - 35 USC § 102

4. Claims 24-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis et al. (A1).

The teachings of Lewis et al. has been set forth in the previous office actions.

Newly submitted claims 68-71 are dependent claims which encompass a method of treating with IGF damage to locus ceruleus associated with Parkinson's disease. Parkinson's disease is associated with damage to the locus ceruleus neurons. Thus, the treatment by the parenteral administration of IGF I or IGF II to treat Parkinson's disease comprise a nonintracranial administration of an IGF in an amount to effective to treat the

Applicants argue that Lewis does not teach parenteral

nonintracranial administration of unmodified IGF peptides reciting specific passages of Lewis. However, Lewis et al. not only teach intracranial administration to overcome the blood brain barrier but also teach the parenteral administration of IGFs which by definition is nonintracranial. Thus, Lewis et al. teach both parenteral and intracranial administration. Furthermore, the claimed limitation directed to IGF is the same scope as the IGF claimed which includes functional derivatives and unmodified IGF.

5. No claims are allowed.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Pak whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Michael D. Pak

Michael D. Pak
Primary Patent Examiner
Art Unit 1646
1 December 1999